

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Nelson Minar	Art Unit	: 3688
Serial No.	: 10/750,361	Examiner	: Donald Champagne
Filed	: December 31, 2003	Conf. No.	: 4924

Title : EMBEDDING ADVERTISEMENTS IN SYNDICATED CONTENT

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF**

Pursuant to 37 C.F.R. § 41.41, the following is the Appellant's response to the Examiner's Answer of May 19, 2011 ("Examiner's Answer").

### **I. Appellant's Response To Examiner's Response To Arguments**

At page 10 of the Examiner's Answer, the Examiner states that "the appellant argues that claiming the use of 'RSS' or 'Atom' specifies a specific type of data. But, in order for the data to be 'specific' to 'RSS' and 'Atom', 'RSS' and 'Atom' need to be defined. 'RSS' and 'Atom' are not defined in the specification...."

According to MPEP 2173.01 "The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. ... Accordingly, **a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible.**" Thus, the terms "RSS" and "Atom" need not be defined by the specification in order for their meanings to be sufficiently clear to one of ordinary skill in the art. Rather, as described below, the terms "RSS" and "Atom" need only have a meaning that is discernible to one of ordinary skill in the art and provides clear warning as to what constitutes infringement. As discussed below, Appellant notes that the RSS specification, a version of which was publicly available prior to the filing of the present application, enables one of ordinary skill in the art to discern the meaning of the term "RSS." As noted by the Examiner in footnote 1 of the Examiner's Answer, an Atom specification was also publicly available, such that the meaning of Atom is also discernable.

At page 13 of the Examiner's Answer, the Examiner states that "The appellant argues that 'RSS' is definite because (1) it is well known and (2) defined by the specification for RSS 1.0. Considering the first argument, as the appellant notes, the criterion is whether or not the meaning of the term is well known and satisfactorily defined in the literature. The examiner has searched widely and could not find an 'explicit' and 'clear' definition of 'RSS' in the specification or elsewhere."

As noted above, the definition of "RSS" need not be provided in the specification if the meaning is discernable by one of ordinary skill in the art. According to MPEP § 2173.02 when determining whether a claim term is definite, "the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and,

therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing **clear warning to others as to what constitutes infringement of the patent.**” “The requirement to 'distinctly' claim means that the claim must have a **meaning discernible to one of ordinary skill in the art** when construed according to correct principles. **Only when a claim remains insolubly ambiguous** without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.” MPEP § 2173.02 quoting *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

Appellant noted in the Appeal Brief that “not only was the meaning of RSS well-known at the time that the present application was filed, but RSS was also satisfactorily defined by the RSS 1.0 specification, which was released prior to the filing of the present application.” Appeal Brief at 11. Appellant’s identification of the RSS 1.0 specification in the Appeal Brief was intended to demonstrate that at the time the application was filed, the RSS specification was readily available to one of ordinary skill in the art, such that the meaning of the terms “Really Simple Syndication” and “RSS” were discernible to those of ordinary skill in the art. These terms are not merely non-functional descriptive material as asserted by the examiner, but rather the specific type of data that are within the scope of the claimed method. For example, upon reading the present specification, one of ordinary skill in the art could have referred to the publicly available RSS specification to determine the scope of the term “Really Simple Syndication” or “RSS” and the type of data to which these terms refer. Thus, the recitation of “Really Simple Syndication” and “RSS” by the claims of the present application provide “clear warning to other as to what constitutes infringement of the patent,” as required by MPEP § 2173.06. Accordingly, the terms “Really Simple Syndication” and “RSS” should be given patentable weight.

In the Examiner’s Answer, the Examiner has misinterpreted the Appellant’s identification of the RSS 1.0 specification as an attempt to limit the claims to the RSS 1.0 specification. Appellant’s identification of the RSS 1.0 standard in the Appeal Brief was not intended to limit the claims of the present application to the RSS 1.0 specification. Rather, the claims recite “Really Simple Syndication” and “RSS” without a version number so that performance of the

method of claim 1 would constitute infringement irrespective of whether the method of claim 1 was implemented with RSS 1.0, RSS 2.0, or other versions of the RSS specification.

## **II. Conclusion**

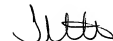
For these reasons, and the reasons stated in the Appeal Brief, Appellant submits that the final rejection should be reversed.

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Respectfully submitted,

Date: \_\_\_\_\_

7/11/11



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